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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,445	11/21/2000	Leo J. Romanczyk JR.	5677-142	1983

7590

04/30/2002

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New York, NY 10166-0153

EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 04/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/717,415

Applicant(s)  
Romanczyk JR, et al.

Examiner  
Christopher Tate

Art Unit  
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 7, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- |  |  |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s).        |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). | 20) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 20-23, drawn to a substantially pure cocoa extract comprising cocoa polyphenols, or a neoplastic composition comprising cocoa polyphenols, classified in class 424, subclass 725, for example.
- II. Claims 12-17, drawn to a method of treating a neoplastic patient via administering an effective amount of a substantially pure cocoa extract or synthetic cocoa polyphenols, classified in class 424, subclass 776, for example.
- III. Claims 18-19, drawn to a kit, classified in class 435, subclass 810, for example.
- IV. Claims 24-25, drawn to a method of preserving or protecting a desired item from oxidation via contacting the item with a substantially pure cocoa extract or synthetic cocoa polyphenols, classified in class 426, subclass 541, for example.
- V. Claim 26, drawn to a method of inhibiting topoisomerase via contacting topoisomerase with a substantially pure cocoa extract or synthetic cocoa polyphenols, classified in class 435, subclass 183, for example.
- VI. Claims 27-42, drawn to a food comprising a cocoa polyphenol as an additive, classified in class 426, subclass 629, for example.

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VII. Claim 43, drawn to a food comprising a synthetic procyanidin as an additive, classified in class 514, subclass 453, for example.

Inventions I, III, VI, and VII (distinct products) and II, IV, and V (distinct processes of use) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, as evidenced by the claims themselves, the distinct products of Groups I, III, VI, and VII can be used in numerous ways - e.g., as an anti-cancer agent, as an enzyme inhibitor, or as an antioxidant, to name a few. Further, there are a vast number of ways to inhibit cancer, preserve food, and/or inhibit topoisomerase, which do not require the use of a cocoa polyphenol - such one or more of those recited in the distinct products of Groups I, III, VI, and VII.

The products of Groups I, III, VI, and VII and the methods of Groups II, IV, and V are distinct, each from the other, because they are directed to different inventions which are not connected in design, operation, and/or effect. These distinct products and methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various inventions at the same time to practice just one invention alone.

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The various inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

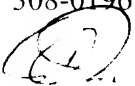
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Based upon other related applications by the instant applicants, it appears that applicants possibly intended to cancel the original claims: claims 1-26. However, at present, claims 1-26, as well as claims 27-43 are currently pending. In addition, please note that supplemental amendments concerning the entering, canceling, and/or amendments of higher numbered claims (e.g., claims 65-80, 81-99) have not been entered due to the confusion these higher claim numbers presented with respect to the original claim numbers (claims 1-26).

As an aside, it is noted that applicants state in the Amendment submitted March 22, 2002 (Paper No.4) that pages 47-54 are missing from the instant specification (it actually appears that pages 47-52 are missing since the original claims begin on page 53). It is strongly suggested that these missing original pages (pages 47-52) of the specification be reinserted into the instant specification, with a statement that the substitute specification contains no new matter (without pages 47-52, there may be confusion and/or new matter considerations with respect to the missing text therein).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1651 is (703) 308-4242.



Christopher R. Tate  
Primary Examiner, Group 1651